



**UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office**

Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/285,292	04/02/99	ALBERTSON	D 023070-09140

020350 HM22/0619
TOWNSEND AND TOWNSEND AND CREW LLP
TWO EMBARCADERO CENTER
EIGHTH FLOOR
SAN FRANCISCO CA 94111

EXAMINER

HARRIS, A

ART UNIT

PAPER NUMBER

1642

DATE MAILED:

06/19/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
09/285,292

Applicant(s)

Albertson et al.

Examiner
Alana M. Harris, Ph. D.

Group Art Unit
1642



☐ Responsive to communication(s) filed on _____

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 35 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 0 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claim

☒ Claim(s) 1-70 is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☐ Claim(s) _____ is/are rejected.

☐ Claim(s) _____ is/are objected to.

☒ Claims 1-70 are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☒ None of the CERTIFIED copies of the priority documents have been
☐ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

— SEE OFFICE ACTION ON THE FOLLOWING PAGES —

Art Unit: 1642

Election/Restriction

- I. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1-8, 13-24 and 28-32, drawn to a method of detecting a predisposition to cancer comprising detecting and measuring the level of *CYP24* mRNA, classified in class 435, subclass 6. Claims 1, 13-18 and 28-32 will be examined with Group I to the extent that it reads on measuring a *CYP24* nucleic acid product.
 - II. Claims 1, 9, 10, 13-18, 25 and 28-32, drawn to a method of detecting a predisposition to cancer comprising detecting and measuring the level of *CYP24* proteins, classified in class 435, subclass 4. Claims 1, 13-18 and 28-32 will be examined with Group II to the extent that it reads on measuring a *CYP24* protein product.
 - III. Claims 1, 11-18 and 26-32, drawn to a method of detecting a predisposition to cancer comprising detecting and measuring the level of 25-hydroxyvitamin D3 24-hydroxylase enzyme, classified in class 435, subclass 7.4. Claims 1, 13-18 and 28-32 will be examined with Group III to the extent that it reads on measuring 25-hydroxyvitamin D3 24-hydroxylase enzyme activity.
 - IV. Claims 33-41 and 46-50, drawn to a method of treating cancer comprising detecting *CYP24* genes, classified in class 424, subclass 1.37. Claim 33 will be examined with Group IV to the extent that it reads on measuring *CYP24* mRNA.

Art Unit: 1642

- V. Claims 33, 42 and 43, drawn to a method of treating cancer comprising detecting *CYP24* protein, classified in class 424, subclass 1.11. Claim 33 will be examined with Group V to the extent that it reads on measuring *CYP24* protein.
- VI. Claims 33, 44 and 45, drawn to a method of treating cancer comprising detecting 25-hydroxyvitamin D3 24-hydroxylase enzyme activity, classified in class 424, subclass 1.61. Claim 33 will be examined with Group VI to the extent that it reads on measuring 25-hydroxyvitamin D3 24-hydroxylase enzyme activity.
- VII. Claims 51-54 and 59-70, drawn to a method of screening a test agent comprising detecting the level of *CYP24* mRNA, classified in class 514, subclass 2. Claim 51 will be examined with Group VII to the extent that it reads on detecting *CYP24* mRNA.
- VIII. Claims 51, 55 and 56, drawn to a method of screening a test agent comprising detecting the level of *CYP24* protein, classified in class 514, subclass 2. Claim 51 will be examined with Group VIII to the extent that it reads on detecting *CYP24* protein.
- IX. Claims 51, 57 and 58, drawn to a method of screening a test agent comprising detecting the level of 25-hydroxyvitamin D3 24-hydroxylase enzyme activity, classified in class 514, subclass 2. Claim 51 will be examined with Group IX to the extent that it reads on detecting 25-hydroxyvitamin D3 24-hydroxylase enzyme activity.

Art Unit: 1642

2. The inventions are distinct, each from the other because of the following reasons:

The methods of Groups I-IX differ in the method objectives, method steps and parameters and in the reagents used.

3. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.


4. Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

5. Attempts to reach Tom Hunter by telephone on June 14, 2000 to request an oral election to the above restriction requirement were unsuccessful.

6. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(I).

Art Unit: 1642

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alana M. Harris, whose telephone number is (703) 306-5880.

A handwritten signature in black ink, appearing to read 'N.A. Johnson', with a long horizontal flourish extending to the right.

NANCY A. JOHNSON, PH.D
PRIMARY EXAMINER

3.